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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/809,868      | 03/26/2004  | Walter Navarrini     | 108910-00127        | 7605             |

4372 7590 03/14/2006

ARENT FOX PLLC  
1050 CONNECTICUT AVENUE, N.W.  
SUITE 400  
WASHINGTON, DC 20036

EXAMINER

KEYS, ROSALYND ANN

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1621

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/809,868

Applicant(s)

NAVARRINI ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6/24/04 & 9/10/04.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-13 are pending.  
Claims 1-13 are rejected.

### ***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Information Disclosure Statement***

3. The information disclosure statements (IDS) submitted on June 24, 2004 and September 10, 2004 have been considered by the examiner.

### ***Claim Objections***

4. Claim 1 is objected to because of the following informalities: the – between R and R<sub>H</sub> in line 25 should be changed to a =. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 1-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
7. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow

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language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 1 recites the broad recitation  $R_f$  is a bivalent radical:  $C_1-C_{20}$ , and the claim also recites preferably  $C_2-C_{12}$  which is the narrower statement of the range/limitation; claim 1 recites the broad recitation  $R_h$  is a  $C_1-C_{20}$ , and the claim also recites preferably  $C_1-C_{10}$  which is the narrower statement of the range/limitation; claim 1 recites the broad recitation and/or functional groups, and the claim also recites preferably selected from  $-SO_2F$ ,  $-CH=CH_2$ ,  $-CH_2CH=CH_2$  and  $NO_2$  which is the narrower statement of the range/limitation; claim 4 recites the broad recitation when  $R_f$  contains one oxygen atom, and the claim also recites preferably is  $CF(OCF_3)CF_2$  which is the narrower statement of the range/limitation; claim 5 recites the broad recitation  $R_{f2}$  is a perfluoropolyoxyalkylene chain having number average molecular weight from 66 to 12,000, and the claim also recites preferably from 100 to 5,000, more preferably from 300 to 2,000 which are the narrower statements of the range/limitation; claim 6 recites the broad recitation  $R_{f2}$  is a perfluoropolyoxyalkylene chain, and the claim also recites it is preferably selected from the following structures a)  $-(CF_2CF_2O)_m$ .....b)  $-(CF_2O)_n$ ..... c)  $-(CF_2CF_2O)_m$ .....which are the narrower statements of the range/limitation; claim 10 recites the broad recitation metal fluorides and the claim also recites preferably alkaline or alkaline-earth metal fluorides which are the narrower statements of the range/limitation.

8. Claim 6 is further indefinite because of the use of the term "limited" in the last line. The term renders the claim unclear because it does not disclose the value that  $R_{f2}$  is limited by

9. Claim 10 is further unclear because of the use of the open term "comprising" in line 2. Alternative expressions are permitted if they present no uncertainty or ambiguity with respect to the question of scope or clarity of the claims. One acceptable form of alternative expression, which is commonly referred to as a Markush group, recites members as being "selected from the group consisting of A, B and C." See

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Ex parte Markush, 1925 C.D. 126 (Comm'r Pat. 1925). Ex parte Markush sanctions claiming a genus expressed as a group consisting of certain specified materials. It is improper to use the term "comprising" instead of "consisting of." *Ex parte Dotter*, 12 USPQ 382 (Bd. App. 1931).

Claims 2, 3, 7-9 and 11-13 are indefinite because they depend from an indefinite claim. *Ex parte Cordova*, 10 U.S.P.Q.2d 1949, 1952 (P.T.O. Bd. App. 1989).


***Allowable Subject Matter***

10. Claims 1-13 are allowable over the prior art of record.
11. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).
12. The following is a statement of reasons for the indication of allowable subject matter: the prior art teaches processes for preparing hydrofluoroethers. However the prior art fails to teach or fairly suggest obtaining said hydrofluoroethers by reacting a mono- or bifunctional carbonyl compound of formula (IV) with a fluoroformate of formula (III).
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M-W & F 4-10pm; H 5:30am-5pm; Sat 8am-1pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Rosalynd Keys  
Primary Examiner  
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March 7, 2006